

RECEIVED
CENTRAL FAX CENTER

FEB 14 2008

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0851-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		MSDI-261/PC750.00	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>February 14, 2008</u> Signature <u>Douglas A. Collier</u> Typed or printed name <u>Douglas A. Collier</u>		Application Number 10/633,288 First Named Inventor Charles L. Branch et al. Art Unit 3733	Filed August 1, 2003 Examiner Anuradha Ramana
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 43,556 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Douglas A. Collier</u> Typed or printed name <u>Douglas A. Collier</u> Telephone number <u>(317) 238-6333</u> Date <u>February 14, 2008</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 38 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

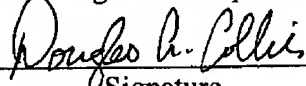
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

FEB 14 2008

KD_IM-1270209_1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No.	52,196	}	<u>Certificate Under 37 CFR 1.8(a)</u>
Group:	3733	}	
Confirmation No.:	3338	}	I hereby certify that this
Application No.:	10/633,288	}	correspondence is being facsimile
		}	transmitted to the United States
		}	Patent and Trademark Office at 571-
		}	273-8300 on
Title of Invention:	SYSTEM AND TECHNIQUES FOR ILLUMINATING A SURGICAL SPACE	}	<u>February 14, 2008</u>
		}	Date of Transmission
Inventor:	Charles L. Branch et al.	}	<u>Douglas A. Collier</u>
		}	Name of Registered Representative
Filed:	August 1, 2003	}	
		}	Signature
Attorney Docket:	MSDI-261/PC750.00	}	<u>February 14, 2008</u>
		}	Date of Signature
Examiner:	Anuradha Ramana	}	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated October 16, 2007, and Advisory Action mailed January 18, 2008, please consider the following. A Notice of Appeal, and form PTO/SB/33 Pre-Appeal Brief Request for Review is submitted herewith along with the fee under 37 CFR 41.20(b)(1). A one month extension of time is enclosed. Please provide any additional extensions of time that may be necessary and charge any additional fees due, or credit any overpayment, to Deposit Account 12-2424, but not including the payment of issue fees.

Response to Final Office Action
Application No. 10/633,288
Docket No. MSDI-261/PC750.00

Page 1 of 5

REMARKS

The present application includes claims 1-29, 31-40, 42-49, and 55-59 which stand rejected in the Final Office Action mailed Oct. 16, 2007. Reconsideration of the Final Office Action was requested in a response filed on Dec. 13, 2007. In addition, a response to the May 1, 2007, non-Final Office Action was filed on Aug. 1, 2007. This Pre-appeal Brief Request for Review requests review of the bases for finally rejecting all claims in this application.

Claims 1-8, 16-21, 26-29, 31, 36-40, 46-49 and 55-59 stand rejected as anticipated by U.S. Patent No. 6,185,356 to Parker et al. Arguments traversing the rejection of these claims were submitted in the Oct. 16 response on pages 2-4 and in the Aug. 1 response on pages 6-11. The examiner maintains the rejection of certain ones of these claims over Parker et al. since the claims purportedly only require the lighting element to have the capability of being frictionally engageable with the inner wall surface of the retractor. It is respectfully submitted that the rejection of base claims 1 and 16 ignores the limitation in these claims that the frictional engagement to be sufficient to maintain a position of the lighting element relative to the retractor.

Claims 1 and 16 set forth an interrelationship between the retractor and the lighting element that serve to define an arrangement, relationship and organization of features not disclosed in Parker et al. Parker et al. rely on a mechanical or adhesive connection to attach the light transmitting member to the accessory device, and there is no disclosure of frictional engagement that maintains the positioning of the lighting element relative to the retractor. Therefore, Parker et al. do not disclose the elements arranged as recited in claims 1 and 16.

With respect to base claims 26 and 36, the examiner asserts that the lighting element of Parker et al. is axially and circumferentially movable along the inner wall surface by means of attachment member 2850. Parker et al. disclose that "[a]ttachment member 2850 can take a variety of suitable forms, including adhesive tape, Velcro fasteners, clips, hooks, tabs, clamps, snaps and the like." See col. 18, lines 52-54. Furthermore, Parker et al. disclose that "protective cover 2850 [sic] may suitably include molded clips, hooks, tabs, or the like, for the attachment of an accessory." Considering that Parker et al. disclose that attachment member 2850 is a mechanical or adhesive connector for attaching the accessory device 2860 to the light transmitting member 2810 in a fixed position, it is submitted that there is no disclosure of an attachment member 2850 that allows the lighting element to move axially or circumferentially

along a surface of accessory device 2860 while maintaining frictional engagement with the wall surface of accessory device 2860 as recited in claims 26 and 36.

Base claim 46 also stands rejected as anticipated by Parker et al. Parker et al. disclose a light transmitting member 2810 with a circular cross-section, which, as best seen in FIG. 28B, includes a convexly curved outer surface 2802 which extends about member 2810 and is exposed to the working channel provided by accessory device 2860. However, concavely curved inner surface 2804 is not exposed to the working channel. Additionally, the embodiment of Figures 25A and 25B fails to disclose a concavely curved inner wall surface of the lighting element or any concavely curved inner wall surface of the lighting element oriented toward and exposed to the working channel of the retractor as recited in claim 46.

Further reasons support patentability of rejected dependent claims. Claims 6, 19, 29 and 39 recite "wherein said inner wall surface of said retractor substantially encloses said working channel and said at least one wall member of said lighting element extends about at least 50 percent of said inner wall surface." Parker et al. do not disclose a retractor with an inner wall surface to which the lighting element is engaged that substantially encloses the working channel.

Claims 7, 20, and 40 recite "wherein said lighting element is movable axially along said inner wall surface while said at least one wall member maintains frictional engagement therewith" and claims 8, 21 and 31 recite "wherein said lighting element is movable circumferentially along said inner wall surface while said at least one wall member maintains frictional engagement therewith." These claims are not anticipated for the reasons provide above with respect to claims 26 and 36.

Claims 1-2, 4-8, 16-21, 26-27, 29, 31, 36-37, 39-40, and 46 stand rejected as anticipated by U.S. Patent No. 3,796,214 to Davis. This rejection is addressed on pages 5-7 of the Dec. 13 response and pages 6-11 of the Aug. 1 response. The examiner maintains that claims 1 and 16 only require the lighting element to have the capability of being frictionally engageable with the inner wall surface of the retractor. It is respectfully submitted that the rejection ignores the recitation in claims 1 and 16 that defines the frictional engagement to be sufficient to maintain a position of the lighting element relative to the retractor as set forth in claims 1 and 16.

Davis merely discloses that a fiber optic bundle is carried in each of the tubular members. There is no disclosure of how the fibers in the bundle are arranged, or that a fiber in the bundle

could be positioned against an inner surface of tubular member 50, 51 in frictional engagement therewith in a manner that is sufficient to maintain a position of another of the fibers in the bundle relative to the tubular member.

With regard to claims 26 and 36, the examiner asserts that the fiber optic bundle is axially and circumferentially movable along the inner wall surfaces of members 50, 51. A review of Davis did not reveal any disclosure of these features. Davis appears to disclose the fiber optic bundle is fixed in members 50, 51 since each member 50, 51 includes a coupler 55 for operatively connecting the fiber optic bundle to a light conducting tube 56. If the fiber optic bundle were moved axially or circumferentially in members 50, 51, it is not clear how the fiber optic bundle could be operatively coupled to light conducting tube 56 since they would no longer be aligned at the end of members 50, 51 for such a connection. Furthermore, members 50, 51 are fixed to retractor 12. See col. 3, lines 32-35.

With respect to claim 46, the examiner asserts Davis discloses a coupler 55 including a pair of wall members or parts that are oriented toward the working channel of the retractor. The rejection fails to address several limitations in the claim, including “a lighting element including a pair of wall members and at least one light transmitting element between said pair of wall members, said pair of wall members forming a concavely curved inner wall surface of said lighting element and an opposite convexly curved outer wall surface of said lighting element, said outer wall surface positionable along said inner wall surface of said retractor with said inner wall surface of said lighting element oriented toward and exposed to said working channel.” Since coupler 55 completely lacks any inner wall surface oriented toward and exposed to a working channel of the retractor, it cannot anticipate claim 46.

In addition to the patentability of the corresponding base claims, further reasons support patentability of rejected dependent claims. For example, claims 3, 18, 28, 38 all recite the same features, yet, claims 3, 28 and 38 were not rejected by Davis. It is not understood how Davis could be properly considered to disclose these same features recited in claim 18.

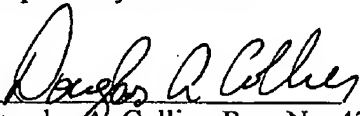
Claims 6, 19, 29 and 39 recite “wherein said inner wall surface of said retractor substantially encloses said working channel and said at least one wall member of said lighting element extends about at least 50 percent of said inner wall surface.” Retractor 12 in Davis does not include any such inner wall surface, nor do the fibers in tubes 50/51 extend about at least 50

percent of any such surface of retractor 12. Claims 7, 20, and 40 recite "wherein said lighting element is movable axially along said inner wall surface while said at least one wall member maintains frictional engagement therewith" and claims 8, 21 and 31 recite "wherein said lighting element is movable circumferentially along said inner wall surface while said at least one wall member maintains frictional engagement therewith." These claims distinguish Davis for the same reasons discussed above with respect to claims 26 and 36.

Claims 9-14, 22-24, 32-34, and 42-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker et al. alone. This rejection was addressed on pages 7-8 of the Dec. 13 response and pages 16-17 of the Aug. 1 response. The examiner asserts "Parker et al. clearly discloses that the lighting device can have a cross-sectional area of any shape. It is also noted that a person of ordinary skill in the art has good reason to choose from a finite number of available shapes, i.e. known options within his or her technical grasp, for providing a cover to a lighting element." The examiner has not identified any teaching of the elements recited in these claims in the prior art, and has not provided any rational reason why one of ordinary skill in the art would modify Parker et al. to arrive at claims 9-14, 22-24, 32-34 and 42-44. Furthermore, even if there is a finite number of shapes from which to choose, the examiner has not identified any prior art teaching of the arrangement in claims 9-14, 22-24, 32-34 and 42-44. It appears that the only teaching to modify Parker et al. is in applicant's own specification, which is not prior art.

It is respectfully submitted that a prima facie case for finally rejecting claims 1-29, 31-40, 42-49 and 55-59 has not been established. Withdrawal of the final rejection is respectfully requested.

Respectfully submitted:

By: 
Douglas A. Collier, Reg. No. 43,556
Krieg DeVault LLP
2800 One Indiana Square
Indianapolis, Indiana 46204-2079
Phone: (317) 238-6333

Response to Final Office Action
Application No. 10/633,288
Docket No. MSDI-261/PC750.00

Page 5 of 5